

SECTION III—REMARKS

This amendment is submitted in response to the Office Action mailed March 15, 2004. Claims 19 and 33 are amended herein, and claims 1, 3-5, 7, 8, 19, and 21-38 remain pending in the application. Applicant respectfully requests reconsideration of the application and allowance of all pending claims in view of the following remarks.

Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 1, 19, 27 and 33 under 35 U.S.C § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. In claims 1, 19, 27 and 33 the Examiner alleges that the meaning of “uniquely identifies” is unclear. In claims 19 and 33, the Examiner alleges that it is unclear how “first and second identification labels” are removably attached to a “designated area,” wherein the “designated area” can only receive “an identification label,” which the Examiner interprets to mean one identification label.

Applicant respectfully traverses the Examiner’s rejections. As to claims 1, 19, 27 and 33, definiteness of claim language cannot be analyzed in a vacuum, but instead must be analyzed in light of the content of the specification, the teachings of the prior art, and the claim interpretation that would be given by one of ordinary skill in the art at the time the invention was made. MPEP § 2173.02. When interpreted in view of the specification, the meaning of “uniquely identifies” is clear. “Uniquely identifies” means that the identifier distinguishes one component from any other component. The embodiment discussed in the specification uses a Media Access Control (MAC) address as an identifier for a network card. Each MAC address is unique—that is, only one of that particular MAC address exists, and it can be associated with only one network card. Since the identifier (*e.g.*, the MAC address) is unique and is associated with a particular component (*e.g.*, a network card), the identifier uniquely identifies the component. In view of the above explanation, Applicant submits that the meaning of “uniquely identifies” is clear and respectfully requests withdrawal of the rejections.

As to the rejection of claims 19 and 33, Applicant has amended the claims to clarify that the “designated area” can receive more than one identification label. Applicant submits that this overcomes the Examiner’s rejection, and respectfully requests withdrawal of the rejections.

Allowable Claims

The Examiner indicated that claims 27-38 would be allowable if re-written or amended to overcome the rejections under 35 U.S.C. § 112, second paragraph. As discussed above, Applicant has overcome all the Examiner's rejections under 35 U.S.C. § 112, second paragraph, of claims 27 and 33. Claim 27 and its dependent claims 28-32 are therefore now in condition for allowance, and claim 33 and its dependent claims 34-38 are similarly in condition for allowance.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1, 3-5, 19, and 21-24 under 35 U.S.C § 103(a) as obvious in view of, and therefore unpatentable over, U.S. Patent No. 5,704,650 to Laurash et al ("Laurash"), U.S. Patent No. 6,536,660 to Blankenship et al ("Blankenship"), one or both of U.S. Patent Nos. 5,783,810 and 5,793,030 to Kelly, Jr. (collectively "Kelly") and U.S. Patent No. 5,227,617 to Christopher et al ("Christopher"). The Examiner also rejected claims 7, 8, 25 and 26 under § 103(a) as obvious in view of, and therefore unpatentable over, Laurash, Kelly, Blankenship and Christopher further in view of U.S. Patent No. 6,348,685 to Brower et al ("Brower").

Applicant respectfully traverses the Examiner's rejections. To establish a *prima facie* case of obviousness, three criteria must be met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. As explained below, the Examiner has not established a *prima facie* case of obviousness.

Claim 1, as amended, recites an article of manufacture comprising a component container and "first and second labels removably affixed to the component container, each label having printed thereon an identifier that uniquely identifies a component inside the component container, the identifier being electronically stored in the component, and the identifier being read from the component and printed on the labels." The Examiner concedes that the combination of Laurash, Kelly and Blankenship does not disclose an identifier electronically stored in the component and read therefrom and printed on labels, but alleges that Christopher discloses an identifier which is read and in turn prints desired information associated with the identifier on a label. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Laurash with an identifier that can be read and printed out on labels through use of a scanner/labeler as taught by Christopher.

Applicant disagrees. Christopher discloses a scanner that can read coded records, but does not disclose, teach or suggest that the coded records read by the scanner are electronically stored in any kind of component. In fact, Christopher teaches quite the opposite—that the coded records are external to the item to which they are attached. Christopher also does not disclose that any scanned record is or should be printed on more than one label. Laurash, Kelly, Blankenship and Christopher, whether alone or in combination, therefore cannot disclose, teach or suggest the recited combination, which includes “first and second labels removably affixed to the component container, each label having printed thereon an identifier that uniquely identifies a component inside the component container, the identifier being electronically stored in the component, and the identifier being read from the component and printed on the labels.” Applicant respectfully submits that the combination attempted by the Examiner therefore cannot obviate the claim, and respectfully requests withdrawal of the rejection.

Regarding claims 3-5, 7 and 8, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 1 is in condition for allowance. Applicant respectfully submits that claims 3-5, 7 and 8 are therefore allowable by virtue of their dependence on allowable claim 1, as well as by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Claim 19 recites an article of manufacture comprising a base label having a designated area thereon to receive an identification label, and “first and second identification labels removably attached to the designated area of the base label, each identification label having printed thereon an identifier that uniquely identifies a component inside a component container to which the base label can be attached, the identifier being electronically stored in the component, and the identifier being read from the component and printed on the identification labels.” For reasons analogous to those discussed above for claim 1, Applicant submits that Laurash, Blankenship, Kelly and Christopher cannot render the claim obvious, and therefore respectfully requests withdrawal of the rejection.

Regarding claims 20-26, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claims 19 is in condition for allowance. Applicant respectfully submits that claims 20-26 are therefore allowable by virtue of their dependence on

allowable claim 19, as well as by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Conclusion

Given the above remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

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